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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,888	03/05/2002	Hans Ulrich Stauber	FRR-12920	8221
40854	7590	05/18/2007		
RANKIN, HILL, PORTER & CLARK LLP 4080 ERIE STREET WILLOUGHBY, OH 44094-7836			EXAMINER HAUGLAND, SCOTT J	
			ART UNIT 3654	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/031,888	<b>Applicant(s)</b> STAUBER, HANS ULRICH	
	<b>Examiner</b> Scott Haugland	<b>Art Unit</b> 3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,12,14-16 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,12,14-16 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the orienting device and positioning device configured such that receipt of the positioning device by the orienting device includes running the orienting device under the positioning device and lifting the orienting device recited in claim 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The originally filed application does not disclose the orienting device and positioning device configured such that receipt of the positioning device by the orienting device includes running the orienting device under the positioning device and lifting the orienting device recited in claim 21. There is disclosure in paragraphs 27 and 47 of the specification (although not shown) of running or swiveling an orienting device underneath the positioning device and lifting the positioning device.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 is unclear since it is directed to a different embodiment of the invention than its parent claim 1. Claim 1 recites an orienting device and a positioning device shown in Figs. 13 and 14 formed so that the positioning device is actively drivable onto the orienting device. The embodiment recited in claim 21 is not shown.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9, 12, 14-16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrmann (U.S. Patent No. 6,264,133) in view of Vainio et al (U.S. Pat. No. 5,286,157) and Ach et al (U.S. Pat. No. 3,887,097).

Herrmann discloses an installation for intermediate storage of flat articles comprising: a number of passively displaceable roll supports 3, 3', a number of winding stations W, a number of storage places for roll supports L, a number of primary transport paths (extending in the Y direction parallel to rails 22 in Fig. 5) each having an

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entrance of one of the winding stations or a plurality of the storage places, a secondary transport path (extending in the X direction in Fig. 5), a number of positioning devices (20, 21, and associated structure for supporting and driving them along rails 22) which travel along the primary transport paths with the roll supports arranged on front sides of the positioning devices, and an orienting device (22 and associated mechanism for orienting and driving in the X direction) which travels along the secondary transport path.

Herrmann does not disclose that the orienting device has a first selectively openable side face for receiving and releasing one of the positioning devices and the positioning devices are able to actively drive onto and off of the orienting device from or to a primary transport path.

Vainio et al teaches providing a storage installation having positioning devices 3 movable along primary paths and an orienting device 2 movable along a secondary path with positioning devices 3 that are able to actively drive onto and off of the orienting device.

Ach et al teaches providing an orienting device 3 for transporting positioning devices 8 with a selectively openable side face 9. An opposite side face is closed (note Fig. 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Herrmann with positioning devices that are able to actively drive onto and off of the orienting device as taught by Vainio et al to improve handling efficiency. It would have been further obvious to provide an orienting device

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having a selectively openable side face as taught by Ach et al to facilitate loading and unloading of the positioning device and to confine the positioning device during movement of the orienting device. It would have been obvious to make one side face of the orienting device always closed so that the positioning devices enter and leave from one side of the holding area of the orienting device as in Herrmann. The orienting devices of Herrmann and Vainio et al are rotatable to orient the positioning devices which must be oriented in a certain way to properly access the primary paths. Only one entrance/exit is required in the orienting device.

The apparatus of Herrmann with and without the above modifications would be capable of receiving and releasing only one of the positioning devices at a time as required by claim 1.

With regard to claim 6, it would have been obvious to support the orienting device by suspending it from a supporting beam since it is old and well known to support elevating devices by suspending them from supporting beams.

With regard to claim 21, it would have been obvious to provide Herrmann with an orienting device and positioning device configured such that receipt of the positioning device by the orienting device includes running the orienting device under the positioning device and lifting the orienting device to transport the positioning devices since it is old and well known to handle articles by apparatus in which the apparatus is run under the article and the apparatus is lifted.

***Response to Arguments***

Applicant's arguments filed 3/8/07 have been fully considered but they are not persuasive.

Applicant argues that the apparatus of Herrmann as modified by Vainio et al would not include an orienting device for accepting only one positioning device at one time. However, the device in Herrmann is capable of accepting only one positioning device at one time as required by claim 1. The device of Herrmann as modified by Vainio et al and Ach et al would, also, be capable of this. It is noted that Vainio et al discloses an orienting device that can hold only one positioning device at a time (Fig. 1).

Applicant argues that there is no motivation to combine the references since Herrmann deals with handling full and empty rolls in relation to winding stations, while Vainio et al deals with only with full rolls. However, both references relate to handling and storage of rolls of material. Vainio et al would be capable of delivering rolls to and from winders. Vainio et al suggests separating the orienting device and positioning device in Herrmann thereby increasing efficiency by allowing the orienting device to act independently of the positioning device and increasing the storage capacity by allowing longer storage rows all serviceable by a single orienting device.

In response to applicant's argument that Ach et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this



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case, both conditions are met. Applicant's apparatus includes an elevator (e.g., in Fig. 14) as do the other applied references.

Applicant argues that Vainio et al does not disclose a positioning device comprising an elevating truck with a fork lift. However, the carriages 3 in Vainio et al are fork lifts similar to the device in Applicant's Fig. 12. See col. 2, lines 61-66 and Fig. 4 of Vainio et al.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. New claim 21 necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

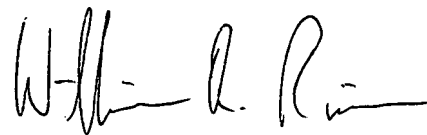
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Haugland whose telephone number is (571) 272-6945. The examiner can normally be reached on Mon. - Fri., 10:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sjh  
5/4/07



**WILLIAM A. RIVERA**  
**PRIMARY EXAMINER**